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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,495	10/14/2003	Trent J. Brundage	P0895	3545
23735 7590 01/08/2007 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			EXAMINER MORAN, RANDAL D	
			ART UNIT	PAPER NUMBER
			2196	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/08/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/686,495

Applicant(s)

BRUNDAGE ET AL.

Examiner

Randal D. Moran

Art Unit

2196

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 73-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 73-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/7/2206, 3/30/2006, 1/6/2006, and 6/24/2004.

### DETAILED ACTION

1. Claims 1-103 are pending in this application. Claims 1-72 were originally presented on 10/14/2003. Claims 73-76 were added in a preliminary amendment filed on 12/8/2005. Claims 76-93 were added in a preliminary amendment filed on 3/30/2006. Claims 1-72 were cancelled and Claims 94-103 were added in a preliminary amendment filed on 8/4/2006. Claims 73-103 are presented for examination.
2. The Information Disclosure Statements filed on 6/24/2004, 1/6/2006, 3/30/2006, and 4/7/2006 have been considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 73, 75-82, 84-91, 93-95, and 97-103** are rejected under 35 U.S.C. 102(b) as being anticipated by **Wang et al. (US 5,337,361)**, herein after "Wang."

7. Considering **Claim 73**, Wang discloses an identification document comprising: a substrate (Fig. 1A- item 16); a first graphic carried on or in the substrate (Fig. 1A- item 17), the first graphic representing a photographic image or artwork (Fig. 1- item 17); and electronic circuitry carried on or in the substrate (column 3- lines 58-61), wherein the electronic circuitry comprises information stored therein (column 4- lines 7-13), the first graphic comprising steganographically encoding including a plural-bit first message that is machine-readable from optical scan data (column 9- lines 19-27) corresponding to at least a portion of said first graphic (column 3- lines 67-68, column 4- lines 1-3), wherein the first message comprises at least a code (column 8- lines 12-19), and wherein the code once obtained unlocks the electronic circuitry or the information stored therein (column 8- lines 38-41).
8. Considering **Claim 77**, Wang discloses an identification document comprising: a substrate (Fig. 1A- item 16); a photographic-representation of an authorized bearer of the identification document carried on or in the substrate (Fig. 1A- item 17, column 3- lines 55-57); machine-readable symbols carded on or in the substrate (column 2- lines 38-40 and 43-47); and electronic circuitry carried on or in the substrate (column 3- lines 58-61), wherein the electronic circuitry comprises information stored therein (column 4- lines 7-13), the machine-readable symbols representing data that is machine-readable from optical scan

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(column 9- lines 19-27) information corresponding to at least a portion of the machine-readable symbols (column 3- lines 58-64), and wherein the data once obtained unlocks the electronic circuitry or the information stored therein (column 8- lines 38-41).

9. Considering **Claim 86**, Wang discloses an identification document comprising: a substrate (Fig. 1A- item 16); a photographic-representation of an authorized bearer of the identification document carried on or in the substrate (Fig. 1A- item 17, column 3- lines 55-57); information carried on or in the substrate (column 4- lines 6-12); and electronic circuitry carried on or in the substrate (column 3- lines 58-61), wherein the electronic circuitry comprises data stored therein (column 4- lines 7-13), wherein the information carried on or in the substrate is recognizable from optical scan data (column 9- lines 19-27) corresponding to at least a portion of the information carried on or in the substrate (column 3- lines 58-64), and wherein at least a portion of the information once recognized unlocks the electronic circuitry or the data stored therein (column 8- lines 38-41).
10. Considering **Claim 94**, Wang discloses an identification document comprising: a substrate (Fig. 1A- item 16); a photographic-representation of an authorized bearer of the identification document carried on or in the substrate (Fig. 1A- item 17, column 3- lines 55-57); information carried on or in the substrate (column 4- lines 6-12); and electronic circuitry carried on or in the substrate (column 3- lines

58-61), wherein the electronic circuitry comprises data stored therein (column 4- lines 7-13), wherein the information carried on or in the substrate is obtainable from optical scan data (column 9- lines 19-27) corresponding to at least a portion of the information carried on or in the substrate (column 3- lines 58-64), and wherein at least a portion of the information is provided for cooperation with the electronic circuitry or the data stored therein (column 4- lines 6-12), wherein the cooperation is to unlock the electronic circuitry or the data stored therein (column 8- lines 38-41).

11. Considering **Claim 101**, Wang discloses an identification document comprising: a substrate (Fig. 1A- item 16); a photographic-representation of an authorized bearer of the identification document carried on or in the substrate (Fig. 1A- item 17, column 3- lines 55-57); information carried on or in the substrate (column 4- lines 6-12); and electronic circuitry carded on or in the substrate (column 3- lines 58-61), wherein the electronic circuitry comprises data stored therein (column 4- lines 7-13), wherein the information carried on or in the substrate is obtainable from optical scan data (column 9- lines 19-27) corresponding to at least a portion of the information carried on or in the substrate (column 3- lines 58-64), and wherein at least a portion of the information once obtained is to be utilized to unlock the electronic circuitry or the data stored therein (column 8- lines 38-41).

12. Considering **Claims 75, 78, 82, 87, 91, 97, and 103**, Wang discloses the identification document comprises at least one of a driver's license, passport, and photo-identification card (column 3- lines 52-55).
13. Considering **Claims 76, 84, and 93**, Wang discloses the information carried on or in the substrate is utilized as at least one of an encryption key and a decryption key (column 10- lines 8-10 and 14-17).
14. Considering **Claims 79, 88, 98, and 102**, Wang discloses the substrate comprises multiple components (column 3- lines 52-55, column 3- lines 58-61).
15. Considering **Claims 80, 89, and 99**, Wang discloses the identification document comprises at least one of a driver's license, passport, and photo-identification card (column 3- lines 52-55).
16. Considering **Claim 81, 90 and 100**, Wang discloses the machine-readable symbols are steganographically hidden in the photographic-representation of the authorized user (column 3- lines 67-68, column 4- lines 1-3).
17. Considering **Claim 85**, Wang discloses the symbols represent human readable information (column 4- lines 38-42).



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18. Considering **Claim 95**, Wang discloses at least a portion of the information - once processed - is for cooperation with the electronic circuitry or the data stored therein (column 3- lines 58-61, column 8- lines 38-41).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 74, 83, and 92** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wang** in view of **Priddy (US 5,984,366)**.

21. Considering **Claims 74, 83, and 92**, Wang does not disclose the substrate comprises multiple layers.

Priddy does disclose the substrate comprises multiple layers (column 4- lines 15-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wang by the multi-layered identification document as taught by Priddy for the benefit of being able to

optically detect the code, notwithstanding that the code is hidden by another layer (Priddy- column 4, lines 21-22).

22. **Claim 96** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Wang** in view of **Kristol et al. (US 5,799,092)**, herein after "Kristol."

23. Considering **Claim 96**, Wang does not disclose at least a portion of the information is to be processed to yield a hash, the hash being for cooperation with the electronic circuitry or the data stored therein.

Kristol does disclose at least a portion of the information is to be processed to yield a hash, the hash being for cooperation with the electronic circuitry or the data stored therein (column 4- lines 57-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wang using the hash function in cooperation with the data stored in the electronic circuitry as taught by Kristol for the benefit of encoding the image signature (Kristol- abstract, lines 10-12) using a well-known hash function (Kristol- column 4- lines 60-61).

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- US 6,389,151- Self-validating security documents.
- US 5,760,386- Improvement to ID documents.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randal D. Moran whose telephone number is 571-270-1255. The examiner can normally be reached on M-F: 7:30-5:00.

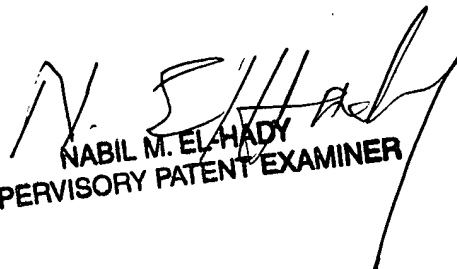
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randal D. Moran

RDM

12/26/06

  
NABIL M. EL-HADY  
SUPERVISORY PATENT EXAMINER